

REMARKS

Claims 1 through 59 are pending in the application. Allowance of claims 1 through 19, 21 through 43, and 59 is appreciated.

All of the amended original claims 1 through 8, and all of claims 9 through 58 added by the reissue application, are repeated as a clean copy in the preceding pages.

No claims have been amended in this Response.

Applicant notes that allowed claims 1-19, 21-43 and 59 have been copied on a continuing reissue application filed on the 17th of February 2000 and has now been assigned serial no. 09/506,288. Absent any basis for rejecting the claims in the co-pending continuing reissue application other than a provisional obviousness-type double patenting rejection, Applicant desires for the newly filed continuing reissue application to be passed to issue.

I. Objection to Claim 1

Claim 1 was objected to because “method of” at line 1 of claim 1 should be read as “method for”. The Examiner is correct in because that portion of claim 1 has never been amended; that portion should be read as “method for” as the Examiner kindly pointed out. “Method of” at line 1 of claim 1 has been corrected to read “method for”. The substitution of “of” for “for” was an inadvertent typographic error. Applicant thanks the Examiner for his careful reading of the Applicant's application.

II. Rejection of Claims 20, and 44-58 under 35 U.S.C. §251

Claims 20 and 44 through 58 were again rejected under 35 U.S.C. §251 as being drawn to

recaptured subject matter. Applicant respectfully traverses this rejection for the following reasons.

A. 35 U.S.C. §251 Allows Reissue Claims Broader in Scope Than The Patented Claims

First, in support of this rejection, the Examiner states:

“The essential reasons argued for the allowability of the originally patented claims 2-7 and 9 according to Applicant exist in the amendment filed 21 October 1993 in the parent file and in the Opinion of the Board of Appeals as to originally numbered claim 8 in the parent file (claim 7 of the patent). The arguments presented by these two sources must now be relied upon to define why the present claims 20 and 44-58 would also be considered allowable over the same art. However, the present arguments in response to the last office action do not coincide with those reasons stated 21 October 1993 as outlined below.

Applicant respectfully invites the Examiner’s attention to the language of 35 U.S.C. §251, which expressly contemplates the right of an applicant to be granted a “reissued patent ... enlarging the scope of the claims of the original patent” The Examiner’s reasoning seeks to incorrectly place a restriction upon the Applicant’s right, by asserting that 35 U.S.C. §251 *sub silento*, requires that claims that enlarge the scope of the claims of the original patent be allowable for the identical reasons argued by an applicant in support of the allowability of the original claims. This is not the law under 35 U.S.C. §251. Accordingly, this rejection can not be maintained.

B. 35 U.S.C. §251 Does Not Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons Different From The Patented Claims

One flaw in this rejection of reissue claims 20 and 44 through 58 is that the Examiner’s expressed rationale is wholly unsupported by either statute, rule of the Commissioner, or judicial

interpretation of the statute. When the Examiner asserts that:

“[t]he arguments presented by these two sources must now be relied upon to define why the present claims 20 and 44-58 would also be considered allowable over the same art”,

the Examiner ignores the absence in 35 U.S.C. §251 of any language that prohibits the allowance of reissue claims that are patentably distinguishable over the prior art for reasons that are different from those reasons that distinguish the patented claims from the prior art. When the Examiner states that,

“the present arguments in response to the last office action do not coincide with those reasons stated 21 October 1993 ”,

the Examiner is improperly endeavoring to limit a reissue applicant to only those claims that are patentably distinguishable over the prior art for the very same reasons as the patented claims. This necessarily limits the applicant to the presentation of reissue claims that are coincidental in breath and scope to the patented claims; such reissue claims would be essentially duplicates of the patented claims. The Examiner’s endeavor ignores the express grant by 35 U.S.C. §251 of the patentee’s right to obtain broader claims within a two year period after the issue of the patented claims. In short, the Examiner has no grant of authority under 35 U.S.C. §251 to reject **claims of enlarging scope that are allowable for reasons not enunciated by an applicant during the examination of the original patent** either in the *Remarks* or in an *Appeal Brief*, or by the Board in a *Decision on an Appeal*. The Examiner’s statement that claims 20 and 44 through 58 are unpatentable under 35 U.S.C. §251 because:

“the present arguments in response to the last office action do not coincide with those reasons stated 21 October 1993 ”,

is specious. Accordingly, there is no lawful basis for maintaining a rejection of reissue claims of enlarging scope, even if those claims are allowable for reasons other than those either argued by the Applicant or stated by the Board of Appeals, during prosecution of the original patent. Withdrawal of this rejection and allowance of claims 20 and 44 through 58, is therefore requested.

C. A Rejection Alleging Improper Recapture Under 35 U.S.C. §251 Must Follow The Procedures of the United States Patent & Trademark Office

A second flaw in the Examiner's reasoning lies in the Examiner's failure to recognize that nothing was surrendered during prosecution of the parent application. The Office action has alleged recapture without following the procedure mandated by the Commissioner. Application of the doctrine of recapture requires that the Examiner follow well defined procedural steps. Judicial interpretations of 35 U.S.C. §251 such as that set forth in *Pannu v. Storz Instruments Inc.*, 59 USPQ2d @ 1600 (Fed. Cir. 2001) earlier cited by the Examiner, details the three-step process for application of the recapture rule. The first step is to:

“determine whether and in what aspect the reissue claims are broader than the patent claims,”

and the second step

“is to determine whether the broader aspects of the reissued claim relate to surrendered subject matter.”

As explained in §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)),

“The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent

claims.” *MPEP* §1412.02.

“The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” *MPEP* §1412.02.

The *Manual* instructs the Examiner that, in order:

“To determine whether an Applicant surrendered particular subject matter, we look at the prosecution history for arguments and changes to the claims made *in an effort to overcome* a prior art rejection.” *MPEP* §1412.02.

The practice outlined by the *Manual* is mandatory.

This rejection action is incomplete under 37 CFR §1.104(b) and (c) because the action not only fails to identify “in what aspect the reissue claims are broader than the patented claims” (that is, to make the first step required by *MPEP* §1412.02), but more significantly, fails “to determine whether the broader aspects of the reissued claims relate to surrendered subject matter” (the second step set forth in *MPEP* §1412.02). In short, this Office action has failed to identify any surrendered subject matter, as is required by the second step of *MPEP* §1412.02. As was discussed in Applicant’s response of the 7th of May 2002, the failure of the Office action to identify surrendered subject matter is directly attributable to the fact that careful examination of the prosecution history establishes an absence of any evidence of record of a surrender of any subject matter during prosecution of the parent application.

Turning now to a review of the amendments made by the Applicant during the prosecution of the original patent, §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)) instructs the Examiner, that:

“To determine whether an Applicant surrendered particular subject

matter, we look at the prosecution history for *arguments and changes* to the claims made *in an effort to overcome* a prior art rejection.”
MPEP §1412.02.

The accompanying table illustrates the progress of examination of claims 2-9 in the parent application, which are now respectively numbered claims 1-8, and graphically illustrates that absence of the “*arguments and changes* to the claims made *in an effort to overcome* a prior art rejection” that are requisite to invocation of the doctrine of recapture, regardless of whether or not the doctrine may be applied to support a recapture.

Claim No.	Type	Amdt. 5/10/93	Amdt. 10/21/93	Office Action 11/23/93	Office Action 3/17/94	Amdt. 6/17/94	Advisory Action 6/23/94	Amdt. 6/30/94	Advisory Action 7/8/94	Board of App. 7/22/97
1	method	cancelled	cancelled	cancelled	cancelled	cancelled	cancelled	cancelled		
2	method			§103	allowed		allowed		allowed	
3	recorder		once	§103	§112¶2	twice	objection	thrice	allowed	
4	recorder		twice	§103	§112¶2		allowed		allowed	
5	recorder		once	§103	allowed		allowed		allowed	
6	recorder		twice	§103	§112¶2	thrice	allowed		allowed	
7	recorder		twice	§103	§112¶2		allowed		allowed	
8	method	new		§§102/103	§§102/103		§§102/103		§§102/103	allowed
9	method	new		§103	allowed		allowed		allowed	

The Preliminary Amendment of the 10th of May 1993 contained clarifying, rather than *Festo* type substantive amendments, to shift the dependencies of claims 4, 6 and 7, and to add independent method claims 8 and 9. In an Office action (Paper No. 5) of the 21st of July 1993, there were multiple and alternative rejections of all claims over Bonneau '623 and Amano '229. A responsive of Amendment filed on the 21st of October 1993, contained clarifying, rather than *Festo* type substantive amendments of independent apparatus claims 3 and 5. The rejections of claims 2 through 7 and 9 were repeated in the Office action of the 23rd of November 1993. Subsequently, in the Office action of the 17th of March 1994, independent method claims 2 and 9 and independent apparatus claim 5 were allowed. Subsequently, claims 3, 4, 6 and 7 were allowed after corrective amendments made on the 17th and 30th of June 1994 in response either to an objection or to a rejection under the second paragraph of 35 U.S.C. §112 alleging possible indefiniteness.

Patented claims 1 through 6 (*i.e.*, including independent method claim 2 and independent apparatus claim 5 in the table) did not recite the clause "checking for a key-data input signal from said keyboard or remote control during a system power stand-by mode" when originally presented or when amended; these claims do not now contain that clause. There is therefore, no basis for the Examiner to assert that the doctrine of recapture requires the presence of this clause in the re-issue claims, because that clause was neither added to patented claims 1 through 6 during prosecution in an effort to avoid a prior art rejection, nor was that clause argued during prosecution as patently distinguishing patent claims 1 through 6 over the prior art. In short, that clause was not present and its wording was not an issue. The doctrine of recapture provides no basis for asserting that the clause "checking for a key-data input signal ... stand-by mode" should be present in the reissue claims 20

and 44 through 58, because that clause was already present in several, but not all of the patented claims when those claims were first rejected. Consequently, that clause was not both added to all of the claims and then argued “*in an effort to overcome* a prior art rejection” as is required by Office practice defined by *MPEP* §1412.02.

Reference to the amendments made during prosecution of the original patent in the light of the foregoing table establishes that the phrases “a character generator”, “a mixer” and “an audio muting circuit” were already present in the claims prior to the first Office action. The “character generator” appeared in original claims 2, 3 and 5 as presented in the Preliminary Amendment filed on the 1st of March 1993. The “mixer” also appeared in independent method claim 2 and independent apparatus claims 3 and 5 in the amendment filed on the 1st of March 1993. The phrase “an audio muting circuit” appeared in dependent apparatus claim 4 and in independent apparatus claim 5 in the Preliminary Amendment of 1 March 1993 and independent method claim 9 newly presented in Applicant’s Supplemental Preliminary Amendment filed on the 10th of May 1993. All of these phrases were present in the pending claims prior to issuance of the first Office action; as is explained in greater detail below, none of these phrases could be said to have been added to the claims by amendment in order “to overcome such prior art applied in the application which matured into the parent for which reissue is being sought”, as is explained by §706.02(£)(1) of the *Manual*.

Turning now from the amendments and examining the remarks made by the Applicant during the prosecution of the original patent, in the *Remarks* of Applicant’s response filed on the 21st of October 1993, Applicant traversed the rejections of claims 2 through 7 and 9 for several “reason(s)”, as was explained on page 12 of that response. These reasons were given in the alternative, and any

one of these reasons was separately sufficient to require a withdrawal of the rejections of claims 2 through 7 and 9:

First, in those *Remarks* Applicant explained that the Examiner's reliance upon a rejection of claim 1 was incorrect, because no rejection had been made of claim 1, and the Examiner had in fact acknowledged that claim 1 had been cancelled prior to the Office action.

Second, those *Remarks* explained that the Examiner's rejection of these claims by reference to the terms of the rejection of method claim 8 was an incomplete rejection, simply because the wording, and thus the field of the subject matter covered by claim 8 was quite different.

Third, in the *Remarks* Applicant explained that one of the two, alternative primary references relied upon by the Examiner to support the several rejections under 35 U.S.C. §103, lacked a "character generator", and could not make a *prima facie* showing of obviousness while the alternative primary reference lacked any showing of any technique for incorporating its character generator into the first alternative primary reference without destroying the intended mode of operation of that first alternative primary reference. These features were already present in independent apparatus claims 3 and 5 and in independent method claim 9 prior to the rejection.

Fourth, Applicant also explained that neither reference contained such other features present in the rejected claims as a mixer. These features were already present in apparatus claims 3 and 5 and independent method claim 9.

Accordingly, Applicant's *Remarks* in the response dated 21 October 1993 traversing "the rejections of claims 2 through 7 and 9 for several "reason(s)" do not constitute the joint acts of "arguments and changes to the claims made *in an effort to overcome* a prior art rejection" that are requisite to invocation of the doctrine of recapture under the mandatory procedure of *MPEP* §1412.02. The Examiner must therefore, re-examine reissue claims 20 and 44 through 58 in accordance with *MPEP* §1412.02. The *Manual* explains the "criteria for determining that subject matter has been surrendered", by stating that:

"[i]f the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. *MPEP* §1412.02.

These criteria are not met where the claims in the original application were allowed, without substantive amendment, over the applied prior art, and both Applicant's *Remarks* and the *Decision on Appeal* by the Board simply demonstrated numerous, alternative features of the original claims that each separately served to distinguish those claims from the prior art. In short, where the original claims are allowable over the prior art because the prior art fails to make a *prima facie* showing, the multiple act criteria required by the *Manual* are not satisfied. Applicant submits however, that in view of absence of the *Manual's* multiple acts of a "limitation ... [that] was originally presented/argued/stated in the original application to make the claims allowable", and the demonstrated absence of the joint acts of "arguments and changes to the claims made *in an effort to overcome* a prior art rejection", no *impermissible* recapture exists under the *Manual's* criteria; this

rejection must be withdrawn and claims 20 and 44 through 58 allowed. Such action is respectfully requested.

D. Where Applicant correctly demonstrates that the prior art fails to teach what the Office action represented that art as teaching, Applicant's demonstration of that failure does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art

As is explained in the foregoing paragraphs, in the Amendment filed on the 21st of October 1993, Applicant correctly explained that the two, alternative primary references relied upon by the Examiner to support the several rejections under 35 U.S.C. §103, lacked several particular structural components of some (e.g., independent apparatus claims 3 and 5, and independent method claim 9) of the rejected claims, and could not support a *prima facie* showing of obviousness, and correctly explained that the Examiner's proposed combination could not be made without destroying the intended mode of operation of the primary reference. Under 35 U.S.C. §102, “[a] person *shall be entitled to a patent unless -*” When an applicant is demonstrating the absence of a *prima facie* showing of obviousness, the applicant is not arguing that particular limitations of the rejected claims render those claims patentable and allowable under the statute, but rather, the applicant is simply explaining that the deficiencies in the Examiner's applied art fail to negate the patentability of those claims. Consequently, Applicant's demonstration in *Remarks* or in an *Appeal Brief* of the numerous deficiencies in the Examiner's rejections does not establish the “surrender” that is an essential condition prerequisite to invocation of the doctrine of recapture. Nowhere did Applicant argue that the features missing from the Examiner's art served to patentably distinguish a patent claim over the

prior art; in the Amendment filed on the 21st of October 1993, Applicant simply demonstrated that there were multiple deficiencies in the art cited by the Examiner, and that those numerous deficiencies prevented the prior art from supporting a rejection under 35 U.S.C. §103. The fact that Applicant separately, and alternatively noted that any of these exemplary deficiencies required withdrawal of the rejections, does not create any basis for invoking the doctrine of recapture because Applicant simply demonstrated the impropriety of the rejection.

By way of a simplified analogy, if the Examiner had cited the first U.S. Patent Grant issued by George Washington on the 31st of July 1790 to Samuel Hopkins for his *Discovery in the Making of Potash and Pearl Ash* to support a rejection of claims 2 through 7 and 9 under 35 U.S.C. §103, and if, in the Amendment filed on the 21st of October 1993, Applicant had explained to the Examiner that the rejection was improper because Hopkins '001 lacked either a *character generator* or a *mixer* or a step of *checking for a key-data input signal from said keyboard or remote control during a system power stand-by mode*, neither 35 U.S.C. §251 nor the doctrine of recapture would thereafter require all of Applicant's reissue claims to contain either a *character generator* or a *mixer* or a step of *checking for a key-data input signal from said keyboard or remote control during a system power stand-by mode*. Applicant's citation of at least three distinct features, and the Board's citation of several other features found to be lacking in the Examiner's art and in the Examiner's proposed combination does not mean that there ever after, reissue claims are limited to combinations that include one or more of these elements, particularly where the prior art not only lacked these elements, but could not have used these elements in the practice of their respective intended modes of operation. The mere fact that Applicant correctly demonstrated to either the Examiner, or the

Board of Appeals, that the prior art failed to teach what the Office action represented that art as teaching, does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art.

Moreover, the fact that neither a *character generator* nor a *mixer* was present in patented independent method claim 7, which was subsequently allowed in response to the decision by the Board of Appeals, further demonstrates the fallacy of the Examiner's assertion that the reissue claims must recite certain limitations that are present in some of the patented claims, but absent from other patent claims. If patented independent claim 7 lacks these elements, the Examiner can not correctly require Applicant to include these elements in any of the reissue claims.

E. Where the Office Action Fails To Make A Finding Of In What Aspects The Reissue Claims Are Broader Than The Patent Claims, and Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter, The Rejection Must Be Withdrawn

The Examiner also asserts that:

Claims 20 and 44-58 are related in scope to like process/method claims in the parent which require the four reasons stated in the prosecution history as discussed above.

Nothing in 35 U.S.C. §251 requires that an applicant's claims of enlarging scope to be "related in scope to like process/method claims in the parent" patent. Where, as here, an applicant chooses to use different nouns and verbs to define his invention, nothing in 35 U.S.C. §251 authorizes the Examiner to maintain a rejection on the grounds now asserted by the Examiner, namely that the rejected claims are not "related in scope to like process/method claims in the parent" patent. The Examiner's reasoning is a *non sequitur* because claims of enlarging scope, by definition, must differ

in scope, and can not therefore, be “related in scope to like process/method claims in the parent” patent. Consequently, the Examiner’s reason given for refusing allowance of claims 20 and 44 through 58 is contrary to logic, unauthorized by statute, and should not be maintained upon reconsideration.

F. The Examiner’s Rejection of Claims 20 and 44-58 Under 35 U.S.C. §251 Is An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability

The Examiner’s assertion that claims 20 and 44-58 are related in scope to like process/method claims in the parent which require the four reasons stated in the prosecution history as discussed above”, the Examiner is, in effect, improperly re-writing U.S.C. §251 to require that the reissue claims contain the same point-of-novelty language as the patented claims. This ignores the fact that the point-of-novelty test has been long discarded by the Court of Appeals, that 35 U.S.C. §251 contains no point-of-novelty criteria and that the statute, as represented by sections such as 35 U.S.C. §103(a), mandates that the Examiner must consider the subject matter claimed “as a whole”, rather than as isolated limitations. Application of the point-of-novelty test ignores the fact that the reissue Applicant’s inventions may be alternatively defined by the interaction of the combination of constituent elements, rather than by a single point-of-novelty phrase. It is therefore, unreasonable to expect, and there is no requirement under §251, that the re-issue claims slavishly parent the language of the patented claims.

G. Alternative Statements Made By The Board Of Appeals To Explain A Refusal To Sustain A Series Of Different Rejections Under 35 U.S.C. §§102 and 103 Are Not Attributable To The Applicant And Do Not Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251

The Examiner further argues the rejection of claims 20 through 44 through 58 on grounds that:

The present rejected claims do not include “checking for a key-data input signal from said keyboard or remote control during a system power standby mode” as required by arguments supported by Applicant found in the Opinion of the Board of Appeals.

The language referred to by the Examiner is the language of the Board of Appeals as written in its *Decision on Appeal*, rather than the language of the Applicant, and that language demonstrates in three distinct paragraphs Nos. 13, 14 and 16, **five** different reasons why Bonneau ‘623 fails to anticipate patented claim 7, and in two distinct paragraphs Nos. 22 and 24, **two** reasons why Amano U.S. 4,620,229 failed to anticipated method claim 8. Applicant has no right of appeal from a decision of the Board of Patent Appeals and Interferences, that completely reverses all rejections; consequently, whatever language may be employed by the Board in its opinion, does not create an estoppel or establish any basis for recapture, simply because the language is by the Board is not either controlled or subject to appeal by the Applicant. Moreover, in many instances, the Board bases its decisions upon factual considerations that are not argued or presented in the Applicant’s Brief. Where, as here, the Board refused to sustain the Examiner’s objections for obviousness under 35 U.S.C. §103, but the “Applicant does not challenge the Examiner’s rejections for obviousness in his Brief”, there is no basis for the Examiner during the reissue prosecution, to claim that arguments presented by Applicant to the Board establish a basis for recapture. In short, no

arguments were made by Applicant, as was noted by the Board in paragraph 8, on page 14, of the its *Decision on Appeal*.

Moreover, the Examiner's assertion that the rejected claims do not include "checking for a key-data input signal from said keyboard or remote control during a system power standby mode" is factually incorrect; reissue claim 20 expressly defines a process for, *inter alia*, "during said system power standby mode of operation, selectively generating a code in dependence upon said evaluation".

As earlier explained herein, even assuming *arguendo* the existence of some sort of bar to recapture in the instant application, the existence of that bar does not deny the Applicant the ability to broaden the scope of coverage by using alternative language to define his inventions. Nothing under the doctrine of recapture requires an Applicant to use the exact and precise language present in the patented claims. Furthermore, some of the patented claims, such as independent apparatus claims 2 and 4, broadly define alternative steps of either checking for an input signal or generating that input signal during a power stand-by state. Accordingly, there is no basis for maintaining a rejection of claims 20 and 44 through 58 on grounds that these claims lack language mentioned by the Board of Appeals in one of its numerous reasons for refusing to sustain any of the several art rejections of then claim 8.

H. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under The Doctrine Of Recapture And A Failure Of The Examiner To Follow The Mandated Procedure Under MPEP §1412.02, Claims 20 And 44 Through 58 Each Define At Least One Of The Constituent Aspects Required By The Examiner

Considering again the Examiner's argument that the rejection of claims 20 through 44

through 58 on grounds that:

“[t]he present rejected claims do not include “checking for a key-data input signal from said keyboard or remote control during a system power standby mode” as required by arguments supported by Applicant found in the Opinion of the Board of Appeals”,

the Examiner’s attention is invited to independent reissue claim 20, which defines, *inter alia*, steps of “during said system power standby mode of operation, selectively generating a code” Some of the original patent claims, such as independent method claim 1 broadly defines an alternative step of “when . . . in said standby mode of operation, receiving a lock function code” and independent method claim 8 states “ checking for an input signal . . . during a system power stand-by state”, while other original claims, such as independent apparatus claims 2 and 4, do not even allude to this aspect of Applicant’s inventions. Even ignoring *arguendo* the absence of evidence of record that supports an impermissible recapture, a fair reading of claim 20 shows the presence of one definition of this code generating aspect of Applicant’s inventions, a feature that is alternatively defined in different language by . Accordingly, this rejection should be withdrawn under the reasoning used by the Examiner.

In further support of the rejection, the Examiner also asserted that:

Alternatively, the following limitations must otherwise be present in these reissue claims where the scope is otherwise commensurate as argued with respect to then method claim 2, now method claim 1:

- a character generator: as stated in the arguments filed on pages 12-13, 21 October 1993;
- a mixer: as required on page 13, first paragraph, in the arguments filed on pages 12-13, 21 October 1993; or

- an audio muting circuit: as stated on page 13, last paragraph in the arguments filed on pages 12-13, 21 October 1993.”

Independent claims 44, 48, 55 and 56 however, which are process rather than apparatus claims, expressly defines the aspects of Applicant’s inventions attributable to a character generator and those attributable to a mixer. Ignoring again *arguendo* the absence of evidence of record that supports an impermissible recapture, a fair reading of process claims 44, 48, 55 and 56 shows the presence of both the character generating and mixing aspects of Applicant’s inventions. Accordingly, using the same reasoning employed by the Examiner, this rejection of claims 44 through 58 must be withdrawn.

The Amendment of 21 October 1993 & the Opinion of the Board of Appeals

In Paper No. 24, the Examiner asserted that:

[t]he essential reasons argued for the allowability of the originally patented claims 2-6 and 9 according to Applicant exist in the amendment filed 21 October 1999 in the parent file and in the opinion of the Board of Appeals as originally numbered claim 8 in the parent file (claim 7 of the patent)."

The Examiner then argues that “the two sources must now be relied upon to define why present claims 20 and 44-58 would also be considered allowable over the same art.” (Paper No. 24, page 2). The Examiner fails to explain why “these two sources must *now* be relied upon to define why claims 20 and 44-58 would also be considered allowable over the same art.

Moreover, Applicant’s amendment of the 21st of October 1993 devotes pages 7 through 11 to discussion of the alternative rejections of patent claim 7 under 35 U.S.C. §102(b) and 35 U.S.C. §103, over either Bonnea U. et al. or Amano et al. Subsequently, in pages 12 through 13 of the

amendment of the 21st of October 1993, Applicant separately discusses the rejections of claims 2-7 and 9 (now patent claims 1-6 and 8) as rejected under 35 U.S.C. §103 over a proposed combination of Bonnea et al. and Amano et al. The language of patent claim 7 differs substantially from the language of patent claim 1-6 and 8, and the arguments and remarks set forth in the amendment of the 21st of October 1993 correspond to the language of the respective claims. By way of example, on page 13, Applicant explained that Bonnea does not “include an audio muting circuit” and “does not teach muting the audio”; consequently reissue claim 56 which addresses controlling the audio signal, corresponds to dependent patent claim 3, rather than to patent claim 7, which claims neither audio muting or an audio muting circuit. The Examiner’s insistence that reissue claim 56 include the novel features of patent claim 7 is therefore misplaced, in view of the gross distinctions between the subject matter covered by patent claims 3 and 7, and the gross differences between patent claim 7 and reissue claim 56.

Patent claim 55 contemplates, among other features, “locking and unlocking said video signal in dependence upon” a “determination whether said second lock key signal is identical to a reference” Patent claim 7 addressed in the Opinion of the Board and in pages 7 through 11 of Applicant’s amendment of the 21st of October 1993, contains no video muting step and no video muting circuit 107, a feature of patent claim 4, rather than patent claim 7 which was the subject of the earlier Appeal to the Board. Patent claim 4 lacks any “system power standby” aspect, and is therefore more similar to reissue process claims 55 and 56. Consequently the Examiner’s insistence that process claims 55 and 56 include features found in patent claim 7, not only ignores the difference in scope between patent claims 4 and 7, but the fact that patent claims 4 and 7 are directed to different subject

matter. The Examiner's assertion that the arguments presented in Applicant's amendment of the 21st of October 1993 to justify patentability of process claims 55 and 56 is therefore unfounded, when patent claim 4 lacks the features associated with Applicant's "*system power standby mode*" aspect of patent claim 7.

Furthermore, the Examiner suggests that the "character generator", "mixer" and "audio muting circuit" be present in the reissue claims. Applicant notes that patent claim 2 contains no audio muting circuit, while reissue claims 55 and 56, although process claims, expressly contemplate both "mixing" and generation of character signals, as well as either "preventing said mixing of said video signal during said locking" claim 55 or "preventing dissemination of said audio signal during said locking state" (as defined by reissue claim 56). It is difficult to understand therefore, in view of the express correlation between process claims 55 and 56 and the Examiner's statements on the bottom of page 2 and the top of page 3 in Paper No. 24, why the Examiner has continued to reject process claims 55 and 56. These claims meet the express requirements enunciated in Paper No. 24. The rejection should not be sustained.

Neither reissue claims 48 nor 44 define Applicant's "*system power standby mode*" of patent claim 7. Both claims however, expressly generate character signals and mix video signals, in conformance with the Examiner's insistence upon the language of method claim 1 set forth at the bottom of page 2 of Paper No. 24. Why the Examiner focused upon the language of patent claim 1 in listing the character generator, mixer and audio muting circuit in Paper No. 24 is unclear. Independent apparatus claim 2 does not define either a video or an audio muting circuit; these features are found in dependent claim 3. Consequently, the Examiner's insistence that the audio

muting circuit of dependent claim 3 be incorporated into independent reissue claims 44 and 48 ignores the breadth of patent claim 2, and improperly denies Applicant's right accorded under 35 U.S.C. §251 to seek broader coverage, by insisting that Applicant amend reissue claims 44 and 48 to incorporate the limitations drawn from dependent patent claim 3. The Examiner cites no authority for his insistence. In a minimum, 35 U.S.C. §251 envisions that Applicant should be able to obtain a reissue claim having a scope at least as broad as independent patent claim 2. Furthermore, the fact that reissue claims 48 and 44 contemplate the character generation and mixing of video signals defined by the character generator and mixer set forth in the bottom of page 2 of Paper No. 24, establishes that reissue claims 48 and 44 are allowable under §251 and the doctrine of reissue recapture, under the criteria enunciated by the Examiner in Paper No. 24. These rejections should not be sustained.

In Paper No. 24, the Examiner explains the rejection of claim 20 and claims 44-58 under 35 U.S.C. §251 and the theory of reissue recapture, by stating that these reissue claims must be "related in scope to like process/method claims present in the parent." The Examiner fails to consider however, that allowability of a reissue claim must be determined on the basis of the entirety of the claim, and not upon the presence or absence of particular single limitations. The Examiner focuses upon Applicant's "system power standby mode", and Applicant notes that this feature is expressly recited in lines 6 and 7 of process claim 20.

The Examiner then asserts that process claim 20 lacks any feature of "checking for a key-data input signal from said keyboard or a remote control" during the "system power standby mode." Independent patent process claim 1 defines the process step of "when ... in said standby mode of

operation, receiving a lock function code from said input device" while reissue claim 20 defines the step of "during said power standby mode of operation, selectively generating a code in dependence upon said evaluation. Paragraph 13, on page 15 of Paper No. 35, the findings of fact and conclusions of law issued by the Board on the 22nd of July 1997, determined that "neither of the references teaches or suggests a reason to initiate the lockout while the system power is off." The Board recognized that it would be "simple enough to modify" these references, but that the Board saw "no motivation to do so."

The language of patent method claim 1 and the explanation set forth by the Board in its Findings establish, is that it is the initiation of "the lockout operation while the system power is off" that is not found in the art, as opposed to the Examiner's assertion that the narrower step of "checking for a key-data input signal from a keyboard or a remote control" during the "system power standby mode" is not found in the art. Claim 20 contemplates the initiation of "the lockout operation" *during said system power standby mode operation*, and expressly defines this in lines 6 and 7. In short, process claim 20 complies with the reasoning given by the Board in its findings as well as conforms to the language of independent patent process claim 1.

Furthermore, independent patent apparatus claim 2 contemplates operational steps that are defined independently of the system power standby mode operation and instead defines the "input device providing a coded sequence and a lock function signal", while independent apparatus patent claim 4 contemplates "a microcomputer responsive to input signals from a keyboard or a remote control receiver; both patent claims 2 and 4 operate upon the input signals received to control the transmission of the video signal, as by video muting. Reissue process claim 20 also responds to the

code by "barring transmission of said first video signal to said video display apparatus." Accordingly, the conformance of reissue claim 20 to apparatus patent claims 2 and 4 together with the explanation given in Paper No. 24 establishing that the art of record did not teach or suggest initiation of "a lockout operation while the system power is off", shows that there is no basis for maintaining the reissue recapture rejection of reissue claim 20.

No Petition for extension of time is required by this Response.

No fees are incurred by this Response.

Entry of this Response pursuant to 37 C.F.R. §1.116(b) is proper because the Examiner has shifted both the rationale and basis for the rejection under 35 U.S.C. §251 of claims 20 and 44-58. Consequently, refusal to enter the foregoing Response denies Applicant a fair opportunity to reply to the shift in the basis for the rejection, thereby according Applicant an opportunity to address the issues rising from the Examiner's shift in rationale.

In view of the foregoing amendments and remarks, all claims are deemed to be in condition for allowance. Should any issues remain unresolved however, the Examiner is respectfully requested to telephone Applicant's attorney.

Respectfully submitted,



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